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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/635,340

08/06/2003

Shigeyuki Nagata

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8079

7590

06/30/2004

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EXAMINER

CAPUTO, LISA M

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

10/635,340

Applicant(s)

NAGATA ET AL.

Examiner

Lisa M Caputo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/611501.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Amendment***

1. Receipt is acknowledged of the preliminary amendment filed 6 August 2003.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference number for step ST16 is on Figure 2(b) but is not mentioned in the specification. Correction is required.

### ***Specification***

3. The disclosure is objected to because of the following informalities:  
On page 6, line 30 of the specification the reference should be to Figure 2(b) instead of Figure 2. The specification should also discriminate between Figures 6(a) and 6(b). There are drawings labeled Figure 6(a) and Figure 6(b), but they are not referenced individually in the specification.

Appropriate correction is required.

Please also add proper headings per below:

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

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- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Double Patenting***

4. Claims 21-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 6,629,643 (hereinafter '643).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claims 21-33 of the instant application, applicants claim a magnetic card transaction apparatus that comprises a card slot, card transferring mechanism, and a detector to detect the insertion of the

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card. In addition, the present invention teaches the use of a shutter and a drive circuit to control the shutter. The '643 patent discloses a magnetic card transaction apparatus that teaches these same elements (i.e. a card slot, card transferring mechanism, and a detector to detect the insertion of the card, etc.). Although the scope of the claims 21-33 of the present application and claims 1-11 of the '643 patent are very similar, the difference between the present claimed invention and the '643 patent is that the present claimed invention is a broader recitation of the '643 patent (i.e. the drive control circuit is explained in much more detail with additional limitations to describe the workings of the machine). Thus, with respect to the above discussions, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of claims 1-11 of the '643 patent as a general teaching for the magnetic card transaction apparatus as claimed by the present invention.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 21-33 are rejected under 35 U.S.C. 102(b) as being anticipated by Sugimoto et al. (U.S. Patent No. 4,803,349, from hereinafter "Sugimoto").

Sugimoto teaches a card read/write device. Sugimoto discloses a magnetic card transaction apparatus (main body of the card read/write device 1) that comprises a card slot from which a magnetic card is inserted (card insertion inlet 2), a card transferring mechanism that takes in the magnetic card inserted from the card slot (card transportation mechanism comprising a pair of upper and lower endless belts and a motor Mo for driving transportation belts 61 and 62), and a detector (device 7 for writing and reading information onto and off of a card, that is, a magnetic head for writing and reading information onto and off of a card as recited in claims 22, 24, and 28) that detects a first condition wherein the magnetic card is inserted from the card slot, the detector further operable to

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detect, after the first condition is detected, a second condition wherein the output of the detector is reduced to substantially zero or is lowered, wherein after the detector detects the second condition, the card transferring mechanism is driven to take in the magnetic card. Further, regarding claim 23, Sugimoto in addition teaches an inlet sensor 3 and a shutter which opens or closes a card guiding path guiding the magnetic card inserted from the card slot to the card transferring mechanism (shutter 4, which is actuated by a solenoid SOL (the shutter controller of the instant application) to open or close the inlet passage). Regarding claims 27 and 29, Sugimoto further teaches a drive control circuit that drives the card transferring mechanism to transfer the magnetic card into the guiding path after the detector detects that the magnetic card arrives at the card transferring mechanism (transportation mechanism driving sensor 5 and circuitry therefore) (see Figure 1, col 2, lines 1-12).

More specifically, and regarding claims 30-33, when the user inserts his or her card A into card insertion inlet 2, the inlet sensor 3 is actuated (S1) so that a protective time T (not shown) is actuated (S2). After about one or two seconds, the solenoid SOL is energized (S3) so that the shutter is forced to move upwardly, whereby the card passage is opened (as recited in claims 25-26 of the instant application). When the user pushes the card A again, the leading end of the card A actuates the driving sensor 5 (S4) so that the motor MO is rotated in one direction, whereby the card A is transported to the right direction in Figure 1. When the card A passes the driving sensor 5, the latter is turned off (S6) and the solenoid SOL is de-energized (S7) so that the shutter is closed. The motor Mo is

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kept rotating in one direction so that the card A is transported in the right direction. During the transportation of the card A, the information stored on the card is read out (detected by magnetic head 7) (S111) and when the END mark is detected (S102), the motor MO is de-energized (S103) and whether or not an amount of money sufficient for sales of goods or service is read out from the card A is detected (S104). This step, where the motor is de-energized, causes a temporary suspension of the insertion of the magnetic card. If the amount of money is not sufficient, the solenoid SOL is energized to open the shutter and to cause the motor Mo to move in the other direction (S10), whereby the card A is transported backwardly to the insertion inlet. When the driving sensor 5 is turned on (S11) and then turned off (S12), the motor Mo is de-energized so that the transportation of the card A is interrupted (S13) and the solenoid SOL is de-energized (S14) to close the shutter. In this case, the shutter is placed upon the end portion of the card A so that when the card A is pulled out, the sensor 3 is turned off (S15) and consequently the device is returned to its standby state. When the motor moves in the other direction, the card moves in the reverse direction temporarily (see Figures 1-3, col 2, lines 13-51).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Lisa M. Caputo** whose telephone number is **(571) 272-2388**. The examiner can normally be reached between the hours of 8:30AM to 5:00PM Monday through Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached at **(571) 272-2398**. The fax phone number for this Group is (703) 872-9306.



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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [lisa.caputo@uspto.gov].

*All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.*

*LMC*

LMC

June 25, 2004

*Jared J. Fureman*  
**JARED J. FUREMAN**  
**PRIMARY EXAMINER**